

Applic. No. 10/045,138
Amdt. dated January 6, 2004
Reply to Office action of October 6, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 3, and 5-18 remain in the application. Claims 1, 3, 7, 9, and 16-18 have been amended. Claims 2 and 4 have been cancelled.

In item 1 on page 2 of the above-identified Office action, claims 7-9 and 11-13 have been objected to because of the following informalities.

More specifically, the Examiner stated that in claims 7, 8, and 9 the recitation "said position point" lacks sufficient antecedent basis. Claim 1 has been amended so as to facilitate prosecution of the application. Therefore, the objection to claims 7-9 by the Examiner has been overcome.

The Examiner stated that in claim 9 the recitation "said first interval" lacks sufficient antecedent basis. Claim 9 has been amended so as to facilitate prosecution of the application. Therefore, the objection to claim 9 by the Examiner has been overcome.

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Additionally, the Examiner stated that in claims 11 and 12 the recitation "said position coordinate line" lacks sufficient antecedent basis. Claim 1 has been amended so as to facilitate prosecution of the application. Therefore, the objection to claims 11 and 12 by the Examiner has been overcome.

The Examiner stated that in claim 13 the recitation "said position coordinate" lacks sufficient antecedent basis. Claim 1 has been amended so as to facilitate prosecution of the application. Therefore, the objection to claim 13 by the Examiner has been overcome.

In item 2 on page 2 of the above-identified Office action, claims 9 and 11-15 have been rejected as being indefinite under 35 U.S.C. § 112.

More specifically, the Examiner has stated that in claim 9 the recitation "said position point of said second transmitter" and "said position point of said first transmitter" is unclear. Claim 1 has been amended so as to facilitate prosecution of the application. Therefore the rejection of claim 9 has been overcome.

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The Examiner stated that in claims 11 and 12, the recitation "said position coordinate line" is inferentially recited. As noted above, claim 1 has been amended so as to facilitate prosecution of the application. Therefore, the rejection of claims 11 and 12 has been overcome.

The Examiner stated that in claim 13, the recitation "said position coordinate" is inferentially recited. As noted above, claim 1 has been amended so as to facilitate prosecution of the application. Therefore, the rejection of claims 11 and 12 has been overcome.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In item 5 on page 3 of the Office action, claims 1-3, 7-12, and 16-18 have been rejected as being fully anticipated by

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Kruger et al. (U.S. Patent No. 5,809,892) (hereinafter
"Kruger") under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 13, lines 8-11 and page 15, lines 12-17 of the specification and in claims 2 and 4 of the instant application.

Since claim 1 has been amended to include the subject matter of claim 4, this response will consider the rejection of claim 1 as indicated below.

In item 7 on page 5 of the Office action, claim 4 has been rejected as being obvious over Kruger (U.S. Patent No. 5,809,892) under 35 U.S.C. § 103.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 16, 17, and 18 call for, *inter alia*:

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the dimensional standard having a pattern with a specific fine resolution.

The corporate assignee of the Kruger reference is also the assignee of the instant application. Therefore, applicants are very familiar with the Kruger reference.

The Kruger reference discloses permanent magnets (40a, and 40b) that are connected by a pole lamination or plate (44).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The reference does not show or suggest the dimensional standard having a pattern with a specific fine resolution, as recited in claims 1 and 16-18 of the instant application. The Kruger reference is silent regarding what object serves as an element detected by sensors (52) (column 6, lines 36-59). If the permanent magnets (40a, and 40b) and the pole lamination or plate (44) of Kruger are considered to be such an object, this could be at best considered to be a dipole magnet. However, it could not be considered a dimensional standard. Furthermore, such a dipole magnet does not have a pattern with a specific fine resolution. This is contrary to the invention

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of the instant application as claimed, in which the dimensional standard has a pattern with a specific fine resolution.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Since claim 1 is believed to be allowable, dependent claims 3 and 7-12 are believed to be allowable as well.

Furthermore, as will be seen from the following remarks, there is no motivation to modify Kruger to arrive at the claimed invention. Kruger does not give any hint that a dipole magnet could be modified to include a pattern with a specific fine resolution. Moreover, none of the other references cited show or suggest the provision of a dimensional standard having a pattern with a specific fine resolution making up part of the rotor part.

Furthermore, the following advantages of a dimensional standard as claimed in the instant application can be found on page 15, line 12 to page 16, line 17 of the specification. First, by using the device according to the invention, given fine and precise configuration of the pattern, high local

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resolution or precision of the registration of the position of the rotor part can be achieved. Also, it makes it possible to achieve a transfer of the dimensional standard from a first transmitter to the next or second transmitter, i.e., calibration of the second output signal by the first output signal. A further advantage of the use of the device according to the invention is that it makes possible a transfer with high precision.

In item 8 on page 6 of the Office action, claim 5 has been rejected as being obvious over Kruger (U.S. Patent No. 5,809,892) in view of Haeberli et al. (U.S. Patent No. 6,288,533) under 35 U.S.C. § 103. The Haeberli et al. reference does not make up for the deficiencies of Kruger. Since claim 1 is believed to be allowable, dependent claim 5 is believed to be allowable as well.

In item 9 on page 6 of the Office action, claim 6 has been rejected as being obvious over Kruger (U.S. Patent No. 5,809,892) in view of Holzapfel et al. (DE 197 48 802 A1) under 35 U.S.C. § 103. The Holzapfel et al. reference does not make up for the deficiencies of Kruger. Since claim 1 is believed to be allowable, dependent claim 6 is believed to be allowable as well.

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In item 10 on page 7 of the Office action, claims 13-15 have been rejected as being obvious over Kruger (U.S. Patent No. 5,809,892) in view of Kruger et al. (U.S. Patent No. 6,240,843) under 35 U.S.C. § 103. The Kruger et al. reference does not make up for the deficiencies of Kruger. Since claim 1 is believed to be allowable, dependent claims 13-15 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 16-18. Claims 1 and 16-18 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 3, and 5-18 are solicited.

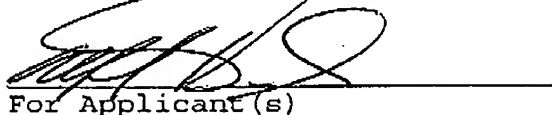
In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

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If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


For Applicant(s)

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